

CERA 233 (10108725)

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 59, 63, 64, 66, 67, 70, 71, 76-79 and 83 were examined. All claims have been canceled, and claims generally corresponding to those claims are now presented as consecutively number claims.

Claims 59, 64, 66, 70, 71, 76, 77 and 83 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Tatematsu. Applicants respectfully traverse.

Tatematsu relates to a yarn cutter for a shuttleless loom. There is no disclosure that the material is "biocompatible bioinert". Each and every limitation of the claims is not taught or suggested by Tatematsu, nor would Tatematsu be concerned with biocompatibility or bioinertness, so the rejection must be withdrawn. At page 3 of the Office Action of March 13, 2006, the Examiner states that "the scissor blades inherently comprise a biocompatible bionert" material since applicants also disclose a silicon nitride ceramic, which is "biocompatible and bionert". The Examiner is referred to U.S. Patent No. 5,879,406 ("Lilly") which discloses at column 8, lines 1-3, that there are biomedical grades of zirconia ceramic. The Examiner has not provided any evidence that Tatematsu similarly discloses a biomedical grade product. To rely on a reference as the basis for a 102/103 rejection on inherency, the Examiner must show that the certain result or characteristic necessarily flows from the teachings of the prior art. See in re Rijckaert, 28 USPQ2d, 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 212 USPQ 323 (CCPA 1981) Ex parte Levy, 17 USPQ2d 1464 (Bd. Pt. App. & Inter 1990) and MPEP §2112. The Examiner's reliance on the cited reference does not meet this standard.

Furthermore, the Examiner should not rely on Applicants teaching to determine what is disclosed in the prior art. Absent any objective evidence proving that Tatematso discloses a "biocompatible, bionert" material, the rejection must be withdrawn since each and every limitation is not disclosed by the cited reference.

CERA 233 (10108725)

Claims 59, 63, 66, 67, 71, 76, 77, 78 and 83 were rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Lilley. Applicants respectfully traverse.

Lilley discloses an artificial bioprosthesis with a head that may be made of YTZP. Even if used a "trial device" as alleged by the Examiner, it is not a "tool" to be used in surgery, it is an implant to be implanted in a subject.

Note that certain claims do not refer to template, e.g., claim 97.


In view of the foregoing, withdrawal of this rejection is respectfully requested.

In view of the foregoing, allowance is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0624, under Order No. NY-CERA 233-US.

Dated: June 6, 2006

Respectfully submitted,

By 
James R. Crawford
Registration No.: 39,155
FULBRIGHT & JAWORSKI L.L.P.
666 Fifth Avenue
New York, New York 10103
(212) 318-3148
(212) 318-3400 (Fax)
Attorneys for Applicant